

REMARKS

Claims 1-21 were originally filed in this application. In light of the office action of December 7, 2006, claims 1 and 12 have been amended and claims 5 and 16 have been canceled. Consequently, claims 1-4, 6-15, and 17-21 remain under consideration. Support for the amendments to the claims can be found in the specification. Therefore, no new matter has been added. Amendment of a claim is not to be construed as a dedication to the public of any subject matter.

Claim Rejections - 35 U.S.C. § 112

The Examiner rejected claim 5 under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation of claim 5 has been promoted into claim 1. An amendment has been made to the wording of the promoted feature, to clarify that the guaranteed successful outcome occurs in the game feature and not in the underlying game. Supporting description may be found in the specification at page 7, lines 3-4, which state that the first two outcomes are guaranteed to be successful.

It is therefore submitted the claims as amended particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim Rejections - 35 U.S.C. § 103

The Examiner has rejected Claims 1-21 under 35 U.S.C. §103(a) as being unpatentable over US 6,702,670 ("Jasper").

Claim 1 defines a gaming machine having a display and a game controller arranged to display images of symbols displayed on the display, the game controller being arranged to play a game wherein at least one random event is caused to be displayed on the display and, if a predefined winning event occurs, the winning event occurs, the machine awards a prize, the

gaming machine further comprising a game feature, where, upon being awarded at least one prize in the feature, a player is offered a choice and, if the choice results in a successful outcome the player has the option of continuing with the feature but, if the choice results in an unsuccessful outcome, the feature ends at a portion, but not all, of a total prize accumulated up to termination of the feature is forfeited, wherein at least one outcome in the feature is guaranteed to be a successful outcome where a player is awarded a prize of a number of credits.

Jasper describes a reel slot machine for playing a bonus game. A player plays a first game on the slot machine according to a first set of odds of winning. If the player wins, the player is given the opportunity to wager the player's winnings on a second "double-up" bonus game. If the user loses the bonus game, the player loses the winnings from the first game. If the player wins the bonus game, the player's winnings are doubled. The player can continue to play the bonus game until the player either loses the bonus game or takes the player's winnings (See abstract and Fig. 1.)

As conceded in the office action, Jasper does not teach forfeiting a portion, but not all, of the total prize accumulated up to termination of the feature.

Furthermore, there is nothing in Jasper that teaches or suggests that at least one outcome in the feature is guaranteed to be a successful outcome.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion of motivation, either in the references themselves or in the knowledge generally available to one skilled in the art, to modify the reference or to combine reference teachings. Second, there must be an expectation of success. Finally, the prior art reference or references when combined must teach or suggest all the claim limitations (See MPEP 2143).

As discussed above, it is submitted that Jasper does not teach or suggest all the claim limitations of claim 1. In addition, there is no suggestion or motivation in Jasper to modify the method of Jasper such that at least one outcome in the feature game is guaranteed to be a successful outcome where a player is awarded a prize of a number of credits.

For at least the reasons described above, it is respectfully submitted that claim 1 is patentable in light of the cited prior art.

Independent claim 12 is a method corresponding to the gaming machine of claim 1. It is submitted that claim 12 is patentable over Jasper for at least the reasons discussed above with respect to claim 1.

The remaining claims in the application are dependent on claim 1 and claim 12. It is submitted that these claims are patentable over Jasper at least by virtue of this dependency. However, each of the dependent claims is deemed to define an additional aspect of the invention and separate consideration of each is requested.

On page 3, the Office Action rejects claims 6-8 and 17-19 on the basis that Jasper teaches that the probability of the game feature is different from the standard game and can vary in many ways.

It is submitted that this assertion is speculative. The mere fact that probabilities may be varied in the prior art games does not teach or suggest any of the specific features claimed in claims 6-8 and 17-19.

Claims 9 and 20 of the present application define a specific equation that may be used to calculate the probability of success in a play of the feature games. On page 4 of the Office Action, the Examiner takes official notice that all games must have a calculated percentage sheet whereas the paytable and game expected win is calculated. The office action states "These odd calculations are not novel but required for implementation of any gaming device, and vary according to the game playing features."

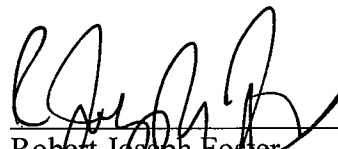
The applicant submits that the equation defined in claims 9 and 20 lies beyond the cited prior art record and is not capable of such instant and unquestionable demonstration as to defy dispute. There is no concrete evidence and record to support the assertion that the calculations at claim 9 and 20 lack novelty. It is respectfully submitted that the rejection of claim 9 and 20 is not properly based upon common knowledge and the Examiner is requested to support the finding with concrete evidence.

Conclusion

Applicants have complied with all requirements made in the above referenced communication. Applicants submit that the present application is in condition for allowance, and therefore, respectfully request that a timely Notice of Allowance be issued in this case. Should matters remain, which the Examiner believes could be resolved in a telephone interview, the Examiner is requested to telephone the Applicants' undersigned agent.

The Director is authorized to charge any additional fee(s) or any underpayment of fee(s), or to credit any overpayments to Deposit Account Number **50-2638**. Please ensure that Attorney Docket Number 75144-011500 is referred to when charging any payments or credits for this case.

Respectfully submitted,


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